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Examiner: Richard Ellis

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Applicant(s): John S. Yates, Jr., et al.

Title: COMPUTER WITH TWO EXECUTION MODES

COMMISSIONER FOR PATENTS

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I certify that this correspondence, along with any documents referred to therein, is being transmitted by facsimile on May 2, 2003 to The Commissioner for Patents, Box AF, Washington D.C. 20231.



## SUPPLEMENTAL PETITION FOR WITHDRAWAL OF FINALITY

Applicant requests withdrawal of finality of the Office Action of October 1, 2002 (the "Second Action"). In summary, withdrawal of finality is requested for several reasons:

- Several claims recite limitations that have never been considered in either the First Action nor the Second Action.
- In a telephone interview, the Examiner plainly admitted that neither the First nor the Second Action set out *prima facie* statements of rejection in the manner required by 37 C.F.R. § 1.104 and Chapter 2100 of the MPEP.
- In the telephone interviews and a series of Advisory Actions, the Examiner explained a number of positions taken in the First and Second Actions. As has now come to light, it is clear that the positions taken in the First and Second Actions are *extremely* aggressive. For example, the Examiner explained that he interpreted the word "necessarily" to include "conditionally." No reasonable applicant could have understood the bases for the rejections from the statements in the First or Second Actions. The Examiner's positions were only revealed in post-final-rejection interviews and advisory actions, too late to allow response, too late to support final rejection.
- The First Action is too sparse in its analysis of any claim to guide any reasonable applicant's response. The elaboration in the Second Action and the Advisory Actions are all "new grounds of rejection" not necessitated by amendment, which prohibit final rejection.

An applicant is entitled to have the grounds for all rejections stated early enough in prosecution that an applicant has a fair opportunity to respond. This Examiner has been hiding the ball. The First Action was only four pages long, with only three pages of analysis of the claims. His positions have only been revealed after final rejection, and only in response to extremely prolonged and detailed questioning. In those subsequent conversations, it has been revealed that a number of statements in the First Action are simply incorrect. No meaningful prosecution by Applicant was possible based on the extremely limited -- and misleading -- analysis in the First and Second Actions. It is not an applicant's burden to discern what the Examiner might have been thinking, but did not write. An applicant is entitled to a complete statement of any rejection in an Office Action, not an Advisory Action, early enough to provide an opportunity to amend any claim that requires amendment. Final rejection is premature.

A Notice of Appeal was filed on April 1, 2003, and the original of this Petition was filed within two months of the Examiner's decisions of February 10, and well within two months of the Examiner's decisions on reconsideration extending throughout March 2003. Accordingly, this Petition is timely.

#### I. Preliminary Statement

The general principles for final rejection are stated in MPEP § 706.07. Final rejection practice is the means by which the PTO "deal[s] justly by both the applicant and the public." The Federal Circuit has further explained the fairness grounds that underlie examination and final rejection:

The process of patent examination is an interactive one. The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a **secret objection** harbored by the examiner. The '*prima facie* case' notion ... seemingly was intended to leave no doubt among examiners that they must state **clearly and specifically** any objections (the *prima facie* case) to patentability, and give the applicant **fair opportunity to meet those objections** with evidence and argument. To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness.

*In re Oetiker*, 977 F.2d 1443, 1449, 24 USPQ2d 1443, 1447 (Fed. Cir. 1992) (Plager, J., concurring, citations omitted, bold added).

The basic requirement for final rejection is that the Office Action must "develop a clear issue for appeal." MPEP § 706.07. The Board explains what it means to "develop a clear issue for appeal," in *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (BPAI 2000): "The examiner has left

applicant and the board to guess as to the basis of the rejection... We are not good at guessing; hence, we decline to guess. ... [T]he examiner has failed to develop the record sufficiently to permit applicant to address the issues and for us to make a cogent ruling on any difference of opinion between applicant and the examiner." If the Board will not review written rejections that leave an applicant or the Board to "guess," then it such rejections are insufficient to support appeal, and finality is premature.

Several legal principles set minimum standards for what must be written down in an Office Action, to ensure that applicants are given sufficient insight into the Examiner's thought process to provide a "fair opportunity" to meet the Examiner's objections. Together, these standards require an Examiner to set out a rejection in sufficient detail so that an Applicant can determine which of four conditions exist: either (a) the rejection can be seen to be correct, or (b) the Examiner's claim interpretation can be determined and can be seen to be incorrect, or (c) the Examiner's interpretation of the reference can be determined and can be seen to be incorrect, and the particular point of error can be determined, or (d) the legal standard applied by the Examiner can be seen to be incorrect. If an Office Action leaves an Applicant guessing among these four possibilities, the Examiner has failed to "develop an issue for appeal," MPEP § 706.07, and has failed his statutory duty to "state the reasons for such rejection ... together with such information and references as may be useful in judging the propriety of continuing the prosecution of his application," 35 U.S.C. § 132. As will be shown below, the two Office Actions were incomplete – and were so misleading that Applicant's best attempts to "guess" at the Examiner's positions were incorrect. Final rejection is premature.

The rules for *prima facie* examination and for final rejection are structured to ensure that an applicant receives a complete and cogent statement of a rejection early enough to allow a proper response. An Advisory Action is simply too late to make these showings. The rules do not provide for making a first attempt to show a *prima facie* rejection in an Advisory Action, because an applicant has no opportunity to respond to grounds for rejection newly-stated in an Advisory. The Advisory Actions in this case are at best present *ex post* explanations for what *might* have been done in the First and Second Actions, but they do not even attempt to show that the required examination was performed in the Office Actions themselves. Applicant certainly appreciates the subsequent elaboration in the Advisory Actions; they have significantly "filled in the gaps" in the Office Actions. However, the Advisory Actions themselves make the existence

of these gaps indisputably clear. The fact that the Examiner felt compelled to provide such significant Advisory Actions proves beyond doubt that the Office Actions themselves were insufficient to mature into final rejections.

## II. The First Action Was So Incomplete That No Second Action Could be Made Final

The first Office Action is facially inadequate to constitute a good faith *prima facie* examination of the claims. 94 claims, twenty pages, were presented of examination. 88 of those claims were rejected in three pages of analysis. Anything added in the Second Action, let alone in any Advisory Action, is a “new ground of rejection.” To the extent that these claims are unamended, these new grounds prevent final rejection.

37 C.F.R. § 1.104(c)(2) reads as follows:

“When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”

Note that Rule 104(c)(2) raises two separate requirements, that the “particular part” of the reference be designated, and that the “pertinence ... must be clearly explained.” *Ex parte Gambogi*, 62 USPQ 1209, 1213 (Bd. Pat. App. & Interf. 2002) (“It is not an applicant’s responsibility to set out a clear and concise rejection ... setting out a rejection is the responsibility of the examiner”).

Neither Office Actions makes any consistent attempt to meet the second requirement. For example, the First Action is a straight paraphrase of an incomplete sample of claim paragraphs, and a “designation” of some portion of the reference said to correspond to the entire paragraph. The only explanation of “pertinence” in the entire First Action appears in the first paragraph of page 4.<sup>1</sup> The Office Action makes no attempt to compare even the independent claims to particular features of the reference. Applicant was left to “guess” what claim construction was intended, what element of the reference was thought to correspond to particular claim elements, how the Examiner thinks that corresponding elements might be interconnected

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<sup>1</sup> Even here, there is no explanation of the pertinence of the reference, only an explanation of subject matter invented by the Examiner. See Affidavit of David R. Levine, ¶ 14. The First Action is entirely silent on the “pertinence” of the reference itself.

in a manner that meets the interconnection limitations of the claims, etc. The explanation of "pertinence" only comes to light in the Second Action and in Advisory Actions.

To take one particular example, in the consideration of claim 22, the first Office Action merely states that certain claim limitations are met at col. 8, line 61 to col. 9 line 57. First Action (paper 8), ¶ 7D and ¶ 9. In the first Response, Applicant attempted to guess at the possible pertinence of the reference, and showed how that pertinence could not meet the claim. Response of June 20, 2002, pages 24-25. In the Second Action, there is no further explanation of how the reference is thought to be "pertinent" to claim 22; merely an incorporation by reference of the First Action. Second Action (paper 11), ¶ 9. Only in the Advisory Actions does the Examiner provide any cogent explanation of how he believes the reference is "pertinent" to these claim limitations. Advisory Action (paper 20), page 1; Advisory Action 3/28/03 (paper 19), ¶ 3. These Advisory Actions give a description of "pertinence" that no reasonable applicant could possibly have guessed, because it is entirely incorrect. Affidavit of David R. Levine, ¶¶ 5-14. Had this explanation been provided at the proper time – in a non-final Office Action – the Examiner's error would have been easy to identify, and prosecution could have moved forward on a prompt and focused basis.

Because the First Action made no attempt to comply with the "pertinence" requirement of Rule 104, it raises no rejection at all. Any rejection that does stand against these claims is necessarily a "new ground of rejection."

Even the Second Office Action makes only a few isolated attempts to meet the second requirement – the Second Action contains only a few scattered explanations of "pertinence." There is almost no comparison of particular claim words to particular features of the reference. Applicant was again left to guess.

Claim 22 is merely one example of many. As became clear in the telephonic interviews and Advisory Actions, the omission of any required explanation of "pertinence" veiled a number of "secret objections" held by the Examiner, in precisely the manner forbidden by the Federal Circuit in *Oetiker*. The failure of the Office Actions to set out the Examiner's position in the manner required by Rule 104 has made it impossible to respond to those "secret objections." The Examiner has begun to explain his rejections only in Advisory Actions. Finality should be withdrawn. If any further rejections are raised, the Examiner should be requested to provide a complete discussion of those rejections (because it will be the first such discussion in any Office

Action in this case, it will necessarily be a non-final Action), so that Applicant will now have a fair opportunity to respond to those positions now made public by the Examiner for the first time in post-final correspondence.

**III. The Examiner has Admitted that He Rejects Claims Based on Unreasonably Broad Interpretations, and does Not Limit Himself to the "Broadest Reasonable Interpretation Consistent With The Specification"**

The Examiner states that he rejects claims "based upon their broadest interpretation." Paper 19 ¶ 16. This is examiner error. MPEP § 2111 states that "During patent examination, the pending claims must be 'given their broadest reasonable interpretation consistent with the specification.'" MPEP § 2111.01 elaborates that when a claim uses a term of art, "the words of a claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art."

As shown below, the Advisory Actions have revealed that two secret claim constructions were unreasonable, even by the Examiner's admission. A number of other claim limitations are construed against the plain meaning that would be understood by those of ordinary skill in the art.

**A. The Examiner has Conceded that He Gave the Term "Necessarily" an Unreasonably Broad Interpretation**

In paper no. 16, the Examiner states that he construes the term "necessarily" of claim 104 to mean something other than "necessarily." Though he does not explain precisely what he believes "necessarily" does mean, from context, it is clear he interprets "necessarily" to allow for exceptions, to mean "possibly" or "not necessarily." In a telephone interview contemporaneous with paper no. 16, the Examiner stated that if the word "necessarily" had been left out of claim 104, he would have construed the claim as permitting no exceptions. He stated that the word "necessarily" introduced some possibility of exceptions into the claim.

No applicant could possibly have guessed that the word "necessarily" was being construed to mean "not necessarily." On a plain reading of the Office Actions, any reasonable applicant would assume that the Examiner has misread the reference. The possibility of an incorrect claim construction cannot be discerned. Had there not been an intensive round of telephone interviews and written Advisory Actions, the unreasonable claim interpretation would never have come to light, and no resolution would have been possible.

In the Examiner's email of March 19, 2003, the Examiner expressly admits that his earlier claim interpretation was incorrect because it was unreasonable, and that the claim "must be interpreted" as advanced by Applicant.<sup>2</sup>

Withdrawal of final rejection is proper, and is the only way to realize the "fairness" and "just dealing" concerns of MPEP § 706.07. The telephone interviews and Advisory Actions have disclosed a number of *extremely* creative claim constructions. When it comes clear that prosecution has been obstructed by the Examiner's violation of PTO requirements for claim interpretation, the Examiner should bear the cost of extending prosecution forward on a reasonable basis, not an applicant.

Final rejection is premature.

**B. "In the TLB"**

Claims 52, 64 and 70 recite that certain information is stored "in" table entries with certain recited properties. These claims are purportedly rejected under § 102(b). Second Action (paper 11) ¶ 5; First Action (paper 8) ¶ 10.

The Office Actions only note that Richter implements a TLB, and points to element 33 of Fig. 3 of Richter, leaving Applicant to guess at the pertinence. *E.g.*, paper no. 8 ¶ 10. The pertinence is not apparent. Fig. 3 of Richter '684 shows that element 33 is on the left side of Fig. 3. The TLB is on the far right side of Fig. 3. How 33 at the left of the figure could be "in" the TLB at the right of the figure is not apparent. Neither Office Action attempts to show that the relevant information in Richter '684 is ever stored in Richter's TLB, as would be required if the TLB were relevant to these claims.

In the Advisory Action of 3/28/03 (paper 19), ¶ 13, the Examiner provides the first explanation of "pertinence" of the reference to the claim. Here, he states that he will ignore the definition of "TLB" in Richter itself, and he will instead rely on a dictionary definition. This is examiner error; Richter is entitled to "be his own lexicographer," and the Examiner errs in ignoring Richter's own "plain meaning" of the terms "in" and "TLB."

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<sup>2</sup> By the Examiner's own admission, the claim has never been examined based on its correct interpretation. A claim that has never been examined cannot be allowed; nor can it be finally rejected. Final rejection is premature.

The Examiner then compounds the error by failing to show that, even under his definition of TLB, the structure he points to in Richter's figure has the other properties recited in these claims.

At this point, all that is clear is that the Examiner has applied an unreasonable claim interpretation that is inconsistent with Richter's specification. However, it is not at all clear what the Examiner's current interpretation of these claims is. Does the claim language "stored in a table" mean "stored in the TLB," "stored on the same page of figures as a TLB," or some other interpretation? What construction is given to the limitations of the claims that interconnect this information and table to other elements, and how does Richter's figure meet these limitations? Until an applicant is apprised of the basis for rejection, final rejection is premature.

**C. Finality Is Premature Before the Examiner Makes Clear All of His Unreasonably Broad Claim Interpretations and Gives Applicant a Fair Opportunity to Respond**

Unearthing the Examiner's "secret objection" relating to "necessarily" took several hours' of telephone calls, and at least two rounds of papers back and forth. Hours and papers more have been expended on the "TLB" issue, and the Examiner has still not put forth any internally-consistent explanation for the relationship between the claims and the reference.

But this is only the tip of the iceberg. There is no way to know how many other claim limitations are being given unreasonably broad claim interpretations. Given the amount of time expended on these two limitations alone, it would be impractical to continue on the current course, and unfair to require Applicant to ferret out the Examiner's "secret objections" word by word. *Oetiker* puts the burden on the Examiner to write his secrets in Office Actions, not to leave an Applicant to guess.

Final rejection is the only rule that the PTO enforces that relates to fundamental fairness. Forcing an Applicant to peel back rejection after rejection, layer by layer by layer is not an efficient use of an examiner's time, and is unfair to an applicant. Final rejection provides the counterweight – a rejection can only be made final when a "clear issue for appeal" is developed. When the Examiner has created such remarkable claim constructions and held them shrouded in mystery, no reasonable applicant could even identify the issue, let alone develop it for appeal.



The Examiner should be instructed that he is to interpret all claim terms in the manner required by MPEP §§ 2111, 2111.01.<sup>3</sup> He should be instructed that any claim interpretation that would raise the slightest bit of surprise must be explicitly stated in any future Office Action. He should be instructed that the "pertinence of each reference, if not apparent, must be clearly explained."

These minimal requirements for a first Office Action are not met by either the First Action or the Second. An incomplete Office Action cannot be made final.

#### **D. The Examiner Relies on Improper Definitions**

In several of the Advisory Actions, the Examiner points to definitions from Webster's Dictionary in order to displace established terms of art in the computer arts. This is examiner error – terms of art "must be read as they would be interpreted by those of ordinary skill in the art." MPEP § 2111.01; *Bell Atlantic Network Systems, Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1267, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) ("we have previously cautioned against the use of non-scientific dictionaries lest dictionary definitions ... be converted into technical terms of art having legal, not linguistic significance.") (citations and quotations omitted).

As is clearly apparent from the specification and as discussed in the accompanying Affidavit of David R. Levine (see ¶¶ 15-20), a number of claim terms have specific definitions in the art that have been ignored by the Examiner. An applicant is entitled to rely on these definitions established in the art. At the very least, an applicant is entitled to an explanation of "pertinence" that will reveal when an examiner is ignoring established definitions. The failure of the Examiner to provide any explanation in the Office Actions of the "pertinence" of the references obscured the fact that he was interpreting the claims improperly.

Once the Examiner discloses his "secret objection," it is relatively simple for an applicant to respond. But the Examiner has disclosed his secret positions only in post-final Advisory

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<sup>3</sup> "The Commissioner has an obligation to ensure that all parts of the [PTO] conform to official policy of the agency, including official interpretations of the agency's organic legislation." *In re Alappat*, 33 F.3d 1526, 1580, 31 USPQ2d 1545, 1588 (Fed. Cir. 1994) (*en banc*) (Plager, J., concurring). Chapter 2100 of the MPEP is the PTO's official interpretation of the agency's organic statute and it is to be applied during initial examination, and the PTO has a duty to enforce that policy during initial examination.

Actions. These Advisory Actions make clear that the Office Actions were inadequate to apprise Applicant of the bases for rejection.

Final rejection is premature. Further, the Examiner should be instructed that he is obligated to set forth the full "pertinence" of each reference, to explain "reasonable expectation of success," and to interpret the claims in the manner required by MPEP §§ 2111 and 2111.01.

**IV. A § 102 Rejection May Not be Made Final Where the Examiner has Admitted that the Reference is Not Identical to the Claim, but is at Best "Equivalent"**

Claims 51-59, 61-75 and 77-78 recite certain properties of "pages." These claims are purportedly rejected under § 102(b). Second Action (paper no. 11), ¶ 5. But neither Office Action ever attempts to show that the claim limitation "page" is identically met by the reference.

After final rejection, the Examiner explains his "secret objection" – he rejects because the "page" of the claim is only "equivalent" to the "segment" of the reference. Advisory Action of 3/28/03 (paper 19) ¶ 5, page 3, line 6. To reject under § 102(b) for mere "equivalence," not "identity," is examiner error.

The Examiner has never considered Richter's clear statement that "pages," at least in the context of the Richter reference, are not even equivalent to "segments." Richter '684, col. 6, lines 62-67 (noting that "segments" need not be "page aligned"). This point of Richter was brought squarely to the Examiner's attention (Response of December 2, 2002, page 13, lines 7-9). See also Affidavit of David R. Levine ¶¶ 17-20. In yet another examiner error, the Examiner failed to "Respond to All Material Traversed" as he was required to do by MPEP § 707.07(f).

No reasonable applicant could have understood the rejection as framed in the First and Second Office Actions, let alone responded to them in a meaningful manner, when the Examiner himself concedes that his § 102 rejection is based on a reference that does not anticipate, and when the Examiner has violated Richter's right to be his own lexicographer. The Examiner's internally-inconsistent "secret objection" was only brought to light in paper 19, an Advisory Action. The explanation in the Advisory Action confirms that the explanation of the "rejection" in the First and Second Actions was too misleading to even provide proper notice of the rejection, let alone guide an applicant's further prosecution.

Final rejection is premature and should be withdrawn.

**V. A Number of Claims Recite Limitations That Have Never Been Examined**

Claims 23, 28, 57, 75, 76, 78-83, 85, 95, 98-100, 102-103, 112, and 116-126 recite specific method steps that are performed in the context of crossing from one "calling convention" to another. In several cases, this language has persisted unamended from initial filing. Neither Office Action designates any portion of any reference as corresponding to this claim limitation; no Office Action explains the pertinence of the reference to this claim limitation.

The only discussion in either Office Actions is

- ¶ 7(c) of the first Office Action and ¶ 22 of the second Action, which discuss only a broader claim limitation ("two different computer architectures and/or execution conventions"), not the specific narrower "calling convention" limitation of any of these claims
- ¶ 13 of the second Action, which makes only a bald assertion that Richter's computer implements two separate calling conventions, with neither a citation to any column and line number at which Richter expressly teaches calling conventions, or any showing of inherency, or any showing that the surrounding claim limitations are met.

Undeniably, Richter '684 teaches that certain things occur on a change of "computer architecture." But this change of "computer architecture," while relevant to claim 1, is entirely irrelevant to the "calling convention" recited in these claims. *Cf.*, Affidavit of David R. Levine ¶ 16.

Further, neither Office Action interrelates any "calling convention" that might be said to exist in Richter '684 to the other interrelated limitations on "calling conventions" recited in these claims. Neither Office Action designates any specific column or line number of Richter '684 that corresponds to the "calling convention" limitations of these claims<sup>4</sup>, nor does it "explain the pertinence" as required by Rule 104(c)(2).

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<sup>4</sup> *In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) ("when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference"); *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (BPAI 2000) (unpublished) ("when an examiner relies on inherency, it is incumbent on the examiner to point to the 'page and line' of the prior art which justifies an inherency theory.")

The first discussion of this limitation appears at ¶ 4 of paper no. 14, an Advisory Action.<sup>5</sup> This is too late. If any rejection is to be maintained, then this claim limitation should be discussed in a non-final Office Action.

## VI. All Obviousness Rejections are Incomplete, and Cannot be Made Final

The Federal Circuit and the Office of the Deputy Assistant Commissioner for Patent Examination Policy have worked together to define the elements of *prima facie* rejections. For example, Chapter 2100 of the MPEP quotes *In re Oetiker*, 977 F.2d 1443, 1445-46, 24 USPQ2d 1443, 1445-46 (Fed. Cir. 1995) as follows, MPEP § 2107.02:

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. ... If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent."

In its original, *Oetiker* continues:

We think that the PTO is correct in treating the concept of the *prima facie* case as of broad applicability, for it places the initial burden on the examiner, the appropriate procedure whatever the technological class of invention.

MPEP § 2142 makes clear that the initial step in any obviousness inquiry lies with the examiner (citations omitted):

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.

*In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1459 ("To reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness."). MPEP § 2142 and *Rouffet* make clear that the first step is the Examiner's. A showing of each element of *prima facie* obviousness is not optional. Until the Examiner takes his first step – coming forward with some evidence, or at least argument – the process of examination and prosecution cannot even begin.

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<sup>5</sup> Note that the Advisory Action makes no attempt whatsoever to show how this claim limitation was discussed in either Office Action; it simply raises the issue entirely anew. This is a clear concession that both Office Actions were defective, and that final rejection was premature.

MPEP §§ 2143 states the minimum requirements that must be met before any *prima facie* § 103(a) rejection can even exist, let alone mature into a final rejection or shift the burden to an applicant to respond (nearly identical statements are reiterated in §§ 2142 and 706.02(j)):

**2143 Basic Requirements of a *Prima Facie* Case of Obviousness**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Director imposed this procedural requirement for "reasonable expectation of success" in order to ensure that an examiner's technological analysis would be correct and complete. The MPEP and *In re Rouffet* are clear, that without a showing of "reasonable expectation of success," no obviousness rejection exists at all.<sup>6</sup> A rejection that does not exist cannot mature into a final rejection.

Here, it is beyond question that no "obviousness" discussion in either Office Action discusses "reasonable expectation of success." In the first Advisory Action (paper 14) ¶ 4, the Examiner explains that he considers himself exempt from this requirement of the MPEP, because he is not examining a chemical process. In a telephonic interview in early March, the Examiner conceded that he did not even realize that there was any requirement for showing of "reasonable expectation of success" until that very day. The Examiner was unable to identify any such showing in any Office Action, and concedes that none exists. This is not a case where there is some disagreement about correctness, or the adequacy of such a showing. Here, Applicant and Examiner have agreed that no showing at all was made in either Office Action.

The only showing of "reasonable expectation of success," and that for only one claim, appears at paper no. 14, ¶ 4.<sup>7</sup> Note that no Advisory Action indicates where showings were

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<sup>6</sup> It is well-established that where an agency employee acts in "brazen defiance" of agency regulations, that employee's action has no legal existence. *Certain Former CSA Employees v. Dept. of Health and Human Services*, 762 F.2d 978, 984 (Fed. Cir. 1985) (action in violation of agency's own regulation is "illegal and of no effect," emphasis added).

<sup>7</sup> There, the Examiner states that the "reasonable expectation of success" requirement only applies in relation to chemical compounds. This is examiner error. "The standards of patentability applied in the

made in the Office Actions; rather, Advisory Action no. 14 merely confirms that the Office Actions were silent, and were thus inadequate to mature into final rejections.

Without that showing, Applicant was unable to determine whether disagreements on the merits related to claim interpretation, the interpretation of the reference, or the legal standard to be applied. By omitting any consideration of "reasonable expectation of success," the Examiner has glossed over a host of substantive technological impossibilities (see Applicant's December 2002 papers and the attached Affidavit of David Levine). If he had attempted to write out any explanation of "reasonable expectation of success," he would likely have found his proposal was impossible, and no rejection would have been raised. If the Examiner's technological error had survived a writing out of "reasonable expectation of success," the precise nature of the Examiner's error would have been clear in the First Action, and Applicant could have responded directly. Instead, the explanation came in Advisory Actions. The Advisory Actions prove that the Examiner's views on "reasonable expectation of success" were necessary to prosecution, to provide some insight into what the Examiner thinks the reference means.

Explanation of the Examiner's view of the reference (a somewhat different showing than "reasonable expectation of success," which still does not exist) was only provided in papers 19 and 20, during the last week before the expiration of the six-month statutory period for response. Now that the Examiner has explained himself, it is clear that his understanding is entirely incorrect. (See, for example, Affidavit of David R. Levine ¶¶ 5-14). Until those last Advisory Actions, no "clear issue" had been developed for appeal. Final rejection, of course, can not arise on an issue first articulated by the Examiner in an Advisory Action. Final rejection is premature.

In paper 19, ¶ 11, the Examiner states that he need not show "reasonable expectation of success" because a patent is presumed to be enabling for any speculation that a creative Examiner can invent. This is clear examiner error. In any obviousness inquiry, the examiner has already conceded that the reference does not teach the subject matter. For the Examiner to apply any presumption of enablement to subject matter that, by the Examiner's own concession, was not invented by the prior inventor, is facially absurd.

In paper no. 16, ¶ 4, the Examiner shifts the burden to Applicant to produce an affidavit challenging "reasonable expectation of success" in any obviousness rejection. (Ironically, in the

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examination of claims must be the same throughout the Office." MPEP § 706. Not even a Group Director has the power to exempt an examiner from a mandatory requirement stated in the MPEP.

same paragraph, the Examiner cites his earlier paper no. 14 in which he conceded that he had never even attempted to make any *prima facie* showing of "reasonable expectation of success." Paper no. 14, paragraph spanning pages 1-2.) This is examiner error. MPEP § 2142 is absolutely clear that no burden shifts to an applicant until the Examiner makes the necessary showing of all three elements of *prima facie* obviousness.<sup>8</sup> The Examiner's position is also just plain silly – until the Examiner has clearly stated his theory of unpatentability, it is impractical to require an Applicant to draft an affidavit that addresses every possible point of disagreement, including all "hidden objections" that an examiner might harbor. An Examiner must not shift the burden until the Examiner has set out his reasoning in sufficient detail to narrow the issues to a few discrete issues for affidavit or appeal.

The MPEP and *In re Rouffet* place the burden on the Examiner to make a *prima facie* showing of "reasonable expectation of success" in a non-final Office Action. There is no basis to remove that burden from the Examiner. It is undisputed that the Second Action fails to demonstrate "reasonable expectation of success," and therefore fails to make a *prima facie* rejection of any claim.

A non-existent rejection cannot mature into a final rejection. Further, the Examiner should be instructed that it is examiner error to reject a claim for obviousness without making the *prima facie* showings required at MPEP §§ 2143-2143.03, and it is examiner error to shift the burden to an applicant before he has done so.

## VII. Conclusion

Applicant petitions that finality of the Office Action of October 1, 2002 be withdrawn. Applicant should then be given an opportunity to respond fully to all issues raised in that Office Action and all subsequent Advisory Actions.

Applicant also requests that the Examiner be instructed that he must follow the MPEP in all respects.

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<sup>8</sup> "The burden to rebut a rejection of obviousness does not arise until a *prima facie* case has been established." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Applicant believes no fee is due. Kindly charge any additional fee, or credit any surplus,  
to Deposit Account 50-0675, Order No. 5231.03-4000.

Respectfully submitted,

SCHULTE ROTH & ZABEL, LLP

Dated: May 2, 2003

By: 

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